No. 3,014,139); Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nikitin in view of Elton '165, and Platzer and further in view of Breitenbach et al. (U.S. Patent No. 4,785,138, hereinafter Breitenbach); Claims 1, 22, 23, and 40-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nikitin in view of Elton '165 and Messenger (U.S. Patent No. 3,908,161); and Claims 1, 24-37, 39, 50, 53, and 57-60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nikitin in view of Elton '165 and Baker et al. (U.S. Patent No. 4,948,209, hereinafter Baker).

Claims 1 and 54 have been amended by way of the present amendment to clarify the invention being claimed. In particular, Claims 1 and 54 have been amended to clarify that the electric winding is formed of a cable having at least one electric conductor, a first layer with semiconducting properties surrounding the conductor, a solid insulating layer surrounding the first layer and a second layer with semiconducting properties surrounding the insulating layer. It is respectfully submitted that the amendments to Claims 1 and 54 find support in the specification as originally filed, and thus, add no new matter.

In the outstanding Office Action, all of the pending claims were rejected based on a hypothetical generator of Nikitin having its winding replaced with the electric cable of Elton '165 and various tertiary, and in some case quaternary references. Applicants maintain their traversal of the rejection based on the proposed combination of Nikitin and Elton '165 for reasons similar to those set forth in the Amendment filed January 14, 2002. All of the arguments supporting Applicants' traversal of the rejections set forth in the Amendment filed January 14, 2002 are incorporated herein by reference.

In the Response to Arguments section of the outstanding Office Action, the Examiner rebuts Applicants' argument that the cable described in Elton '165 would not

be suitable for use as a stator winding. The Office Action asserts that Elton '165 "clearly associate their invention with a high powered electrical apparatus such as a dynamoelectric machine."[1]

In response, Applicants respectfully submit that the Examiner has mischaracterized this particular passage from Elton '165. As discussed in the Amendment filed October 9, 2001, Elton '165 is a continuation of the application that led to U.S. Patent No. 4,853,565 (hereinafter Elton '565), which includes a more complete context for the passage cited in the outstanding Office Action. The invention in Elton '565 is the use of a pyrolyzed glass fiber layer in various applications, for example, as a layer of a bar-type winding of a dynamoelectric machine, as layers of a cable, and as a coating for a housing for electronic components. Given this background, when the complete paragraph of the passage of Elton '165 is read (i.e., col. 1, lines 22-35), it is clear that the windings of the dynamoelectric machine being discussed in the passage cited in the Office Action are actually conventional bar-type windings, or armature bars: "[h]eavily insulated electrical windings, or armature bars, are disposed in the slots."[2] It is therefore respectfully submitted that the cited passage of Elton '165 is not suggesting that the cable illustrated in Figure 1 of Elton '165 may be used as a winding of a dynamoelectric machine.

The Office Action further asserts that:

> [t]his teaching is sufficient to one of ordinary skill in the art familiar with [the] machine designed by Nikitin et al. to contemplate usage of the cable disclosed by Elton et al. in the high voltage dynamoelectric machine for the purpose of simplifying the cable structure by eliminating the cooling while reducing the thickness of the cable insulation. The

[1] See Office Action dated March 14, 2002, at numbered paragraph 2, pp. 10-11.
[2] See Elton '165, at column 1, lines 25-35.

> method of forming or using the cable in such [a] machine is not germane to the issue of patentability of the device itself.[3]

For a proper obviousness rejection based on a combination of references, there must be evidence in the references themselves showing that there was a motivation to combine the references, or from what was known to one of ordinary skill in the art, not merely that it was feasible to combine the references. It is respectfully submitted that there is no evidence (1) of a desirability to modify the winding used in Nikitin, (2) to suggest that the cable described in Elton '165 could be used as a stator winding, nor (3) that one of ordinary skill in the electric machine art would have a reasonable expectation of success if the generator in Nikitin was modified to operate with cable windings that have the structure of the cable described in Elton '165. Nikitin is directed to a technique for providing insulation sleeves for a portion of half-windings in an attempt to save insulation.[4] Nikitin does not suggest a desirability to simplify the cable structure of the half-windings as asserted in the outstanding Office Action. Furthermore, as explained in detail in the Amendment filed January 14, 2002, the cable of Elton '165 would be prohibitively rigid for use as a stator winding.

Consequently, the motivation asserted in the outstanding Office Action is unsupported by any evidence indicating that the proposed combination of Nikitin and Elton '165 is desirable or technically feasible. Accordingly, it is respectfully submitted that one of ordinary skill in the electric machine art would not have been motivated to combine the cable in Elton '165 with the generator in Nikitin.

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[3] See Office Action dated March 14, 2002, at numbered paragraph 2, p. 11.
[4] See Nikitin at col. 3, lines 57-60.

In the recent CAFC decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), the court stressed the requirement for basing obviousness rejections on evidence, and not on conclusory statements made by an Examiner to support a rejection:

> When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.[5]
>
> ...In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the Examiner and the Board are presumed to act from [the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains"]. Thus, when they rely on what they assert to be general knowledge to negate patentability, the knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.[6]

It is respectfully submitted that the rejections set forth in the outstanding Office Action and the rebuttal of Applicants arguments are based on conclusory statements, and not based on evidence as is required to be consistent with the guidance set forth in *In re Lee*.

Furthermore, as is clearly set forth in the MPEP at § 2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness", and "[w]ith regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than

[5] *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002).
[6] *Id.* at 1435

not." Applicants respectfully submit that the Examiner has not met this burden.

Consequently, in view of the present amendment, and in light of the foregoing comments, as well as the arguments set forth in the Amendment filed January 14, 2002, it is respectfully submitted that the invention defined by Claims 1-55 and 57-60, as amended, is patentably distinguishing over the asserted prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,

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Amendment Filed on: 6-13-02

IN THE CLAIMS

Please amend Claims 1 and 54 as follows:

--1. (Three Times Amended) An electric power plant comprising at least one alternating current electric machine designed to be connected directly to a distribution or transmission network and comprising at least one electric winding formed of a cable, wherein the winding of the machine comprises at least one electric conductor, a first layer with semiconducting properties surrounding the conductor, a solid insulating layer surrounding the first layer and a second layer with semiconducting properties surrounding the insulating layer, and auxiliary power means arranged to provide an auxiliary power.

54. (Three Times Amended) An electric power plant comprising at least one alternating current rotary electric machine for connection directly to a distribution or transmission network and comprising at least one electric winding formed of a cable, wherein the winding of the machine is formed of at least one electric conductor, a first layer with semiconducting properties surrounding the conductor, a solid insulating layer surrounding the first layer and a second layer with semiconducting properties

surrounding the insulating layer, and an auxiliary power is generated with the aid of an extra winding on a stator.--